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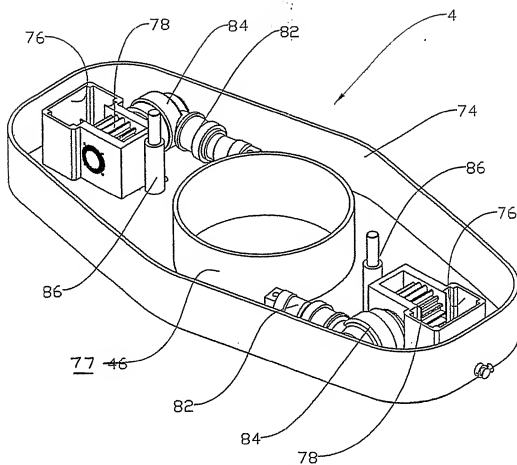


Fig. 5

### REMARKS

The Applicant has reviewed and fully considered the September 21, 2007 Office Action received in the above-referenced application. In regards to the drawings and the specification, the Examiner objected to the drawings as failing to comply with 37 CFR 184(p)(4) because reference character “46” had been used to designate both piston and retainer ring. Office Action, para. 1. Figure 5 has been amended and the specification, page 7, line 18, has also been changed accordingly. The Examiner also objected to the specification for failing to provide section headings in accordance with 37 CFR 1.77(b). *Id.* at para. 1. The specification has been amended accordingly. The Examiner also objected to the disclosure because of an informality, namely, page 7, line 21, referenced “figures 1 and 2” rather than “figure 5.” *Id.* at para. 2. The specification has been changed accordingly.

In regards to the claims, Claims 1–3, 6, and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. (U.S. Patent No. 2,923,192) in view Applicant’s Admitted Prior Art, page 1, lines 5–9. *Id.* at para. 4. Claim 6 has been rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied to Claim 1, further in view of Buck (U.S. Patent No. 6,253,643). *Id.* at para. 5. Claims 7–9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied to claim 1, further in view of Keast et al. (U.S. Patent No. 4,246,809). *Id.* at para. 6. Last, Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art as applied to Claim 1, further in view of Schulze-Beckinghausen (U.S. Patent No. 5,081,888). Each of these 103(a) rejections is discussed in turn.

The rejection of Claim 1 turns on an alleged admission by the Applicant that prior art tongs “hav[e] a swivel coupling surrounding the tong for transferring pressure from an external source to

the tong.” Office Action, page 4, lines 5–6. Applicant, however, has not admitted any prior art. By way of background, the Applicant’s application is entering the national stage based upon an earlier filed European application. As is normal practice in Europe, the features of the first paragraph of the description gives a résumé of the invention. A reading of the entire first paragraph reveals that it is not a discussion of prior art tongs but rather of tong usages:

This invention regards a power tong. More particularly, it regards a power tong without a radial opening, the power tong being particularly well suited for use during installation of piping when drilling in the ground, such as is known from e.g. petroleum production. The tong has a swivel coupling surrounding the tong for transferring pressurized fluid from [a]n external source of pressurized fluid to the tong when the tong rotates about the longitudinal axis of the pipe.

Specification, page 1, lines 2–9.

“The tong” refers to “this invention.” The “such as is known” language refers to the types of applications for which “[t]his invention”—and power tongs in general—are particularly well suited: “installation of piping when drilling in the ground, such as is known from e.g. petroleum production.” Lines 5–9, therefore, do not admit “that [prior art] tongs having a swivel coupling surrounding the tong for transferring pressure from an external source to the tong,” nor do those lines admit that the Applicant’s unique power tong is “old and known in the art.” See Office Action, page 4, lines 5–6.

Furthermore, Montgomery discloses a tong that includes a swivel ring through which hydraulic fluid flows to and from radially directed hydraulic piston members 15 in a circular gear wheel 8. Montgomery, Figs. 1–4. Montgomery fails to disclose—nor suggest, teach, or motivate—the feature of “a plurality of clamping devices . . . gathered in a group, where the group of clamping devices are removable from the drive ring.” Claim 1, lines 7–9. If Montgomery’s gear wheel 8 is comparable to Applicant’s drive ring 30, then each piston member 15 of Montgomery

would have to be removed individually from gear wheel 8. However, Montgomery's gear wheel 8 is not comparable to Applicant's drive ring 30. Accomplishing Applicant's invention, therefore, requires modifying Montgomery far beyond that of adding "a swivel coupling and to make the jaws separable for easing of maintenance or replacements." *See* Office Action, page 4, lines 10–11. Because Applicant's disclosure does not contain admitted prior art, and because gear wheel 8 of Montgomery is not comparable to Applicant's drive ring 30, Claim 1 should be allowed. Because Claims 2 and 3 depend from Claim 1, those claims should also be allowed. Claim 4, which depends from Claim 1 and has been objected to as being dependent upon a rejected base claim (Office Action, para. 8) should also be allowed.

The rejection of Claim 6 turns on Montgomery in view of Applicant's Admitted Prior Art, further in view of Buck. As stated and explained above, Applicant has not admitted any prior art. Although Buck does disclose jaw assemblies that are removable, Buck does not teach, suggest, or motivate the essential features of Claim 1 as discussed above. Claim 6 depends from Claim 1. The Applicant therefore believes Claim 6 is in condition for allowance.

The rejection of Claims 7–9 turns on Montgomery in view of Applicant's Admitted Prior Art, further in view of Keast et al. As stated and explained above, Applicant has not admitted any prior art. Keast does disclose a back-up tong that is displaceable relative to the power tong along two guide columns. However, because the rods 12 in Keast are fixed to the back-up tong, only the power tong is movable along the two rods 12. *See* Keast, fig. 2. Keast does not disclose "the power tong together with a back-up tong being vertically displaceable along at least two guide columns" as found in Claim 8. Rather, Keast teaches away from the Applicant's unique feature. Keast specifically states that "the backup tong 11 preferably rests upon and is removably secured to support base 15." Keast at col. 3, lines 47–48; *see also id.* at figs. 1 & 2. Therefore, Keast's back-up tong is

not designed to move to a position of stick-up prior to gripping a pipe and Keast contains no teaching, suggestion, or motivation for the Applicant's Claims 7-9. For the foregoing reasons the Applicant contends Claims 7-9 are allowable.

The rejection of Claim 7 and 10 turns on Montgomery in view of Applicant's Admitted Prior Art, further in view of Schulze-Beckinghausen. Again, the Applicant has not admitted any prior art. Schulze-Beckinghausen discloses cup washers 134 surrounding pillars 115, 116. *See* col. 4, lines 64-65. However, neither Schulze-Beckinghausen, nor any of the other cited art, discloses a collective bellow for collecting the content of the pipes. This is a unique feature of the Applicant's invention as disclosed in the specification. Claim 10, therefore, has been amended accordingly: "A power tong in accordance with Claim 7, further comprising a space between the power tong and the back-up tong shielded by a collecting bellows, the collecting bellows being positioned so as to collect a content of the pipe." Due to the above reasons the Applicant believes Claims 7 and 10 are in condition for allowance.

The Applicant believes that he has addressed all the outstanding issues and that the application is in condition for allowance and therefore respectfully requests allowance of the claims. Should any other amendments be necessary to place the application in condition for a Notice of Allowance, Examiner Shakeri is invited to call the undersigned at the below noted telephone number.

Enclosed is a Petition and Fee for a One-Month Extension of Time. Please charge Deposit Account No. 50-1971 the amount of \$60.00 to cover this extension of time fee. Further, please debit additional fees required by this paper or credit any overpayment to Deposit Account No. 50-1971.

Respectfully submitted,

A handwritten signature in black ink, reading "Chad M. Hinrichs", is written over a horizontal line.

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